



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,819	03/23/2001	Kurt Kemper	112791.1100	8216

6449 7590 02/04/2005

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT PAPER NUMBER

3726

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,819

Applicant(s)

KEMPER ET AL.

Examiner

Marc Jimenez

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-20 and 22-64 is/are pending in the application.
- 4a) Of the above claim(s) 19,20,22-52 and 59-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-18,53-58,63 and 64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3726

DETAILED ACTION

Specification

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

2. The disclosure is objected to because of the following informalities: headings of each section of the specification should be included as discussed above.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1, 2, 4-18, 53-58, 63, and 64** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “wherein said workpiece is worked by said at least one roll in sequence in opposite directions” which renders the scope of the claims unclear. For example, if only one roll is provided (since the claims recite “at least one roll”), it is unclear how the workpiece is worked by the roll in sequence in “opposite directions” if there is only one roll.

Claim 6 recites “said at least one bore” in the last two lines which lacks proper antecedent basis.

Claim 8 recites “said at least one bore” in the last two lines which lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1, 2, 4, 12-18, 53, 54, 58, and 63** are rejected under 35 U.S.C. 102(b) as being anticipated by Back (US 1,196,343).

Back teaches a method for surface treatment of metallic workpieces (col. 1, lines 10-14) in which a metallic workpiece is worked at least in part by at least one roll **a-e** provided at least in part with an outer profile having the form of annular beads and recesses (see figure 1, **c,e** and figure 2, **a,b,d**), comprising the steps of: exposing a treated surface (col. 1, line 13-14) of the workpiece to compressive stresses, and exposing zones located beneath the treated surface of the workpiece to tensile stresses axially and tangentially through contact with the annular beads (col. 2, lines 75-85), wherein the workpiece is worked by the at least one roll **a-e** in sequence in opposite directions.

Regarding claim 2, the workpiece is considered to move in an axial direction because as the workpiece is rotated by roller **a** in figure 2, the workpiece will move in the axial direction of the rollers as the workpiece is bent.

Regarding claim 4, the workpiece has a round treated surface (col. 2, lines 93-94, pots and cans are round) and is worked by at least one roll **a-e** provided at least in part with an outer profile arranged parallel to the workpiece and which is rotatable about the longitudinal centerline thereof as well as about the workpiece.

Regarding claim 12, the treated surface includes at least one flat surface because pots and cans have at least one flat surface and is worked by at least one roll provided at least in part with an outer profile arranged substantially perpendicular or at an angle to the workpiece (see figure 1 for the profiles of the rollers **a-e**).

Regarding claims 13-17, there are five sets of rollers a-e which are considered to meet the claimed step of “is worked or supported by at least one further roll” as claimed.

Regarding claim 18, the coating is paint (col. 1, lines 23-24).

Regarding claim 54, the workpiece is solid metal (col. 2, line 93).

Regarding claim 53 and 58, note that iron is used (col. 2, line 93).

Regarding claim 63, the workpiece is worked by two rolls a-e.

7. **Claim 64** is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Back.

It is inherent that metal cans (col. 2, line 94) are made of aluminum or alloyed aluminum because cans are typically made of aluminum.

Alternatively, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have used aluminum for cans, in order to provide a light weight and strong material.

8. **Claims 1, 2, 4, 5, 53, 56, 58, and 63** are rejected under 35 U.S.C. 102(b) as being anticipated by Nagahara (US 3,606,780).

Nagahara teaches a method for treatment of metallic workpieces **11** in which a metallic workpiece **11** is worked at least in part by at least one roll **12,13,13',14,14'** provided at least in part with an outer profile having the form of annular beads and recesses, comprising the steps of: exposing a treated surface (The inner surface of the pipe **11** is considered to be treated because it is made from stock material which is shaped to obtain the cylindrical profile of a pipe. A forming step is considered a treating step.) of the workpiece **11'** to compressive stresses, and exposing

Art Unit: 3726

zones located beneath the treated surface of the workpiece 11' to tensile stresses axially and tangentially through contact with the annular beads 15, wherein the workpiece 11' is worked by the at least one roll 12,13,13',14,14' in sequence in opposite directions (for example the roll 13' has a portion 24' that bends the radially inward and the roll 12 has a portion 15 that bends the metal radially outward at figure 1).

Regarding claim 2, the workpiece is moved in an axial direction by the at least one roll 12,13,13',14,14'.

Regarding claim 4, the workpiece 11 has a round treated surface.

Regarding claim 5, the workpiece 11 has a bore in the center.

Regarding claims 53 and 58, the pipe 11 is metal.

Regarding claim 56, the workpiece 11 that is treated is an interior surface of a bore.

Regarding claim 63, note that there are at least two rolls 12,13,13',14,14'.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claim 55** is rejected under 35 U.S.C. 103(a) as being unpatentable over Back in view of Shiau (US 4,640,500).

Back teaches removing a coating from metal in order to reuse the metal. However, Back

Art Unit: 3726

does not specifically teach using the metal for headrest coiled springs.

Shiau teaches that it is known to use metal for coiled springs **11**.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Back with using the metal for coiled springs, in light of the teachings of Shiau, in order to create a shock absorber for automobiles.

11. **Claim 57** is rejected under 35 U.S.C. 103(a) as being unpatentable over Back in view of Fredrick.

Back teaches removing a coating from metal in order to reuse the metal. However, Back does not specifically teach using the metal for headrest brackets.

Fredrick teaches that it is known to use metal for headrest brackets **20** in automobiles that have at least one flat surface.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Back with using the workpiece for headrest brackets in automobiles, in light of the teachings of Russell, in order to make a structural support for an automobile seat.

Response to Arguments

12. Applicant's arguments with respect to claims 1, 2, 4-18, 53-58, 63, and 64 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Interviews After Final

14. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

Art Unit: 3726

Contact Information

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number (571) 272-4530. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 273-4530. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Marc Jimenez
Primary Examiner
Art Unit 3726

MJ
February 2, 2005